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Attorney Docket No. 5728,0448-00

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TECH CENTER 1600B-9001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Serge RESTLE et al.) Group Art Unit: 1619
)
Application No.: 09/360,521) Examiner: L. Wells
)
Filed: July 23, 1999)
)
RCE Filed: February 4, 2002)
)
For: AMINATED SILICONE)
DETERGENT COSMETIC)
COMPOSITION AND USE)

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

PRELIMINARY REMARKS

The final Office Action dated October 4, 2002, and the Advisory Action dated January 22, 2002, have been received and carefully considered. Reconsideration is requested in light of the following remarks.

REJECTIONS UNDER 35 U.S.C. §102(b)

The Advisory Action dated January 22, 2002, did not state whether the rejection of claims 1-12, 22-25, 32, 39, and 43-46 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,185,087 to Morlino (Morlino) was maintained. In a telephone conference with the Examiner on January 30, 2002, the undersigned confirmed that the rejection under section 102 over Morlino had been withdrawn. Confirmation for the record is respectfully requested.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-46 were rejected under 35 U.S.C. § 103(a) as obvious over Morlino in view of U.S. Patent No. 5,567,428 to Hughes (Hughes) and in further view of U.S. Patent No. 5,476,649 to Natio et al. (Natio). Applicants respectfully traverse this rejection.

In order to establish a *prima facie* case of obviousness, the Office must present evidence of (1) a motivation to modify or combine the references, (2) a reasonable expectation of success for the proposed modification or combination, and (3) a teaching or suggestion of all the claimed elements. See M.P.E.P. § 2143. In the present case, this burden has not been met, and the Office has not substantively responded to Applicants' arguments, as required under M.P.E.P. §§706, 706.07.

As set forth in Applicants' reply of January 4, 2002, the Office has not shown and Morlino does not teach or suggest a composition comprising both an anionic and an amphoteric surfactant, much less a composition with both surfactants at the claimed ratio. Moreover, the Office has not shown and Morlino does not provide any motivation for selecting a composition comprising both an anionic and an amphoteric surfactant, much less a composition with both surfactants at the claimed ratio. Furthermore, Hughes and Natio have not been cited for and do not overcome these deficiencies.

Accordingly, for at least the reasons that not all the claimed elements are taught or suggested, and that there is no motivation to make the suggested modification/combination, a *prima facie* case of obviousness has not been established. Reconsideration and withdrawal of the rejection is respectfully requested. Should the

rejection be maintained, a response to Applicants' arguments, as required under M.P.E.P. §§706, 706.07, is further requested.

DOUBLE PATENTING

The Advisory Action January 22, 2002, did not state whether the double patenting was maintained. To the extent that Claims 1-46 remain rejected for obviousness-type double patenting over the claims of U.S. Patent Nos. 6,028,041, 6,159,914, 6,022,836, and 5,650,383, Applicants respectfully traverse this rejection for the reasons of record and as further discussed below.

In order to support an obviousness-type double patenting rejection, the Office must establish the same obviousness criteria as for a rejection under 35 U.S.C. § 103. In the present case, however, none of U.S. Patent Nos. 6,028,041, 6,159,914, 6,022,836, and 5,650,383 teaches, suggests, or claims, among other things, the claimed amphoteric/anionic surfactant ratio. The Office has not presented and the references do not contain sufficient evidence to establish that the presently claimed invention is obvious over any or all of these patents.

Accordingly, reconsideration and withdrawal of the rejections is respectfully requested. Should the rejection be maintained, a response to Applicants' arguments, as required under M.P.E.P. §§706, 706.07, is further requested.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com


Applicants further request an in-person interview with the Examiner prior to any substantive action in this case.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 4, 2002

By: 
Mark J. Feldstein
Reg. No. 46,693

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com